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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,520	07/23/2002	Hendrik T. van de Grampel	GEPL.P-056	6633

21121 7590 09/03/2003
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EXAMINER

MULVANEY, ELIZABETH EVANS

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-5

Office Action Summary

Application No.

10/064,520

Applicant(s)

VAN DE GRAMPEL ET AL.

Examiner

Elizabeth E. Mulvaney

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other:

Art Unit: 1774

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-39 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Thompson et al.

Thompson et al disclose an optical disk comprising a substrate having data formed thereon, a reflective layer, a reactive layer, and a second substrate (See Figure 2). The reactive layer may be formed of a leuco methylene blue and a tin ethylhexanoate reducing agent (See claims 1, 11 and 21).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-39 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,5,9 of copending Application No.

Art Unit: 1774

09/681,288. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim the same disk having a leuco methylene blue dye which is reduced using a tin ethylhexanoate. It is recognized that the reducing agent is not claimed. However, when looking to the specification to define the reducing agent of claim 9, the specific reducing agent is found in Example 1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The art cited discloses a disk having a read-inhibiting agent including a leuco dye.

Any inquiry concerning this communication should be directed to Elizabeth Evans Mulvaney at (703) 308-4423. The examiner can normally be reached Monday through Thursday from 9:00 AM to 6:00 PM and on alternating Fridays from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached at (703) 308-0449.



Elizabeth Evans Mulvaney
Primary Examiner
Group 1700

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OCT 31 2002

TC 1700

ATTORNEY DOCKET NO. GEPL.P-056

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**INFORMATION DISCLOSURE STATEMENT
BY APPLICANT**

Application No: 10/064,520

Filing Date: July 23, 2002

First Named Inventor: van de Grampel

Confirmation No.: 6633

Group Art Unit: 1773

Examiner Name:

Attorney Docket No. GEPL.P-056

Page 1 of 2

Examiner's Initials	US Patent Document	Name of Patentee or applicant of cited document	Date of Publication of Cited Document	Pages, Columns, Lines Where Relevant Passages or Relevant Figures Appear
SPM	5,815,484	Smith, et al.	Sept. 29, 1998	
	6,011,772	Rollhaus, et al.	Jan. 4, 2000	
	6,338,933	Lawandy, et al.	Jan. 15, 2002	
	6,343,063	Rollhaus, et al.	Jan. 29, 2002	
	2001/0046204	Rollhaus, et al.	Nov. 29, 2001	

FOREIGN PATENT DOCUMENTS

Examiner's Initials	Cite No.	office	Number	Kind Code	Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document	Pages where relevant passages appear	T ^o
SPM			PCT/NL01/00822		Chawla, et al.	May 16, 2002		

Examiner's Initials	OTHER PRIOR ART – NON PATENT LITERATURE DOCUMENTS

This Information Disclosure Citation List is being submitted as a substitute for Form PTO-1449. The Examiner is requested to place his or her initials on the lines adjacent to the citations to indicate that the reference has been considered. The Examiner is further requested to fill in his or her name and the date the information was considered in blocks at the bottom of this substitute for Form PTO-1449.

Examiner SP Murwanay Date Considered 8-20-03